APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
08/907,635	08/08/97	ENOKIDA	M	35.C10457CON

LM02/0907

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112-3801

EXAMINER	
HONG, S	
ART UNIT	**PAPER NUMBER**
2776	35

DATE MAILED: 09/07/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)
	08/907.635	Enokida et al.
	Examiner	Group Art Unit
	Hong	2776

—*The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address*—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE __three__ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☑ Responsive to communication(s) filed on __6-19-97__ .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) __1-13, 36, 37 and 40-52__ is/are pending in the application.

Of the above claim(s) __NONE__ is/are withdrawn from consideration.

☐ Claim(s) ____ is/are allowed.

☑ Claim(s) __1-13, 36, 37 and 40-52__ is/are rejected.

☐ Claim(s) ____ is/are objected to.

☐ Claim(s) ____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on ____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on ____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☑ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☑ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☑ received.

☐ received in Application No. (Series Code/Serial Number) ____ .

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: ____ .

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). ____

☐ Notice of References Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other ____

Office Action Summary

Part III   DETAILED ACTION

1.   This action is responsive to communications: CPA and preliminary amendment filed

6/19/99 to the application filed 8/8/97, which is a FWC of the application Ser. No.

09/378,819, filed 1/27/95.

2.   In the amendment claims 45-52 have been added. Accordingly, claims 1-13 and 40-52

are pending in this case.

3.   The rejections of claims 5-13 and 40-42 under 35 U.S.C. § 103 as being unpatentable

over <u>Bonomi</u> in view of <u>Normille</u> et al., and claim 44 under 35 U.S.C. § 103 as being

unpatentable over <u>Bonomi</u> in view of <u>Nguyen</u> have been withdrawn as necessitated by the

amendment.

Priority

4.   Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers

have been placed of record in the file.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form

the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6.   Claims 1-4, 36, 45 and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by

Bonomi, U.S. Pat. No. 5,577,191, 11/96 (filed 2/94).

As per independent claim 1, Bonomi discloses the following claimed elements of a

moving image editing apparatus:

- converting means for converting encoded moving image data encoded by an encoding

method that includes encoding using interframe correlation to an intraframe encoded moving

image (col.2, line 54, "The video compression circuit ...compress the video data ...using both

interframe and intraframe algorithm ...[and the] video decompression circuit decompresses

intraframe-only compressed video data to allow editing");

- storing means for intraframe coding the decoded moving image data and storing the

intraframe encoded image data (col.4, line 25, "...in FIG.2, intraframe-only compressed video

data is retrieved from storage" shows that the data have been stored.);

- editing means for decoding the image data which was stored in said storing means and

intraframe encoded, and for performing an arbitrary editing on the encoded image data (col.2,

line 57, "intraframe-only compressed video data ...allow video editing to occur in the host

processor."); and

- coding means for coding the edited image data by an encoded method that includes

encoding in which the interframe correlation is considered (col.2, line 59, "When the video

editing is complete, the video ....the video compression circuit to compress the video data

using both intraframe and interframe algorithm.").

As per dependent claim 2, Bonomi discloses that the **animating image data is**

transmitted from an external apparatus by communication (see "VTR", item 101, in FIGs.

1 and 2).

As per dependent claim 3, Bonomi discloses **an edition in a time base direction**

between frames (col.1, line 52, "Typical editing activities include special effects, titling,

mixing, fades and wipes...").

As per dependent claim 4, Bonomi discloses **displaying the decoded image data**

(col.3, line 52, "...decompressed the video data to display the video images on display").

Independent claim 36 is for a method performed by the apparatus of claim 1, and is

similarly rejected under the same rationale.

Independent claims 45 and 47 recite substantially similar limitations as claims 1 and 36,

respectively, and are similarly rejected under the same rationale. Furthermore, Bonomi

teaches that the moving image data are encoded by MPEG (see col.1, lines 25+, "the standard

is the MPEG...").

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. § 103 which forms the basis for all
obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically.disclosed or
described as set forth in section 102 of this title, if the differences between the subject

matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

8.   Claims 5-13, 37, 41-42, 44 46, 48, 50 and 52 are rejected under 35 U.S.C. § 103 as

being unpatentable over <u>Sugiyama</u>, U.S. Pat. No. 5,315,326, 5/94 (filed 4/92) in view of

<u>Nguyen</u>, U.S. Pat. No. 5,404,437, 4/95 (filed 11/92) and of <u>Normille et al.</u>, U.S. Pat. No.

5,267,334, 11/93. All references previously provided to the applicants.

As per independent claim 5, Sugiyama discloses **decoding moving image data**

encoded by an encoding method that includes at least encoding in intraframe correlation

(col.5, line 21, "Since respective frames are independently coded..." shows that each frame is

coded with intraframe correlation, and not interframe correlation.; col.4, line 9, "...detecting

...pixel of an image ...where interframe or interfield processing is carried out"") ; storing

means for storing the moving image data (col.4, lines 11-19; and col.3, lines 48-53,

"independently coding respective frames ...so that respective frames can be independently

handled"). However, Sugiyama does not disclose an editing means for **arbitrary** edition.

That feature is taught by Nguyen (col.2, lines 3-11, "An animation sequence generator

decompresses and stores information representing the pixel data ...synchronizes the animation

sequence..."). It would have been obvious to a person of ordinary skill in the art at the time

the invention was made to have used Nguyen's apparatus to edit the animation data of

Sugiyama, since Sugiyama has pointed out that intraframe coded images "mak[e] it possible to

easily carry out ... random access, high speed search or image editing in media of the storage

system (col.3, lines 54-57)."

Secondly, Sugiyama does not explicitly show the means for detecting and decoding the

image and a predetermined number of frames after the detected image. This feature, however,

is shown by the prior art of Normille. Normille discloses **detecting an intraframe** (col.7,

line 59, "detecting a first scene ...known, in a preferred embodiment, as a ...intra frame");

and **decoding the image and a predetermined number of frames after the detected image**

(col.7, line 66, "generating at least one intermediate compressed frame...containing difference

information from the first image for at least one image following the first image in time in the

sequence of moving images") **decoding moving image data encoded by an encoding method**

that includes encoding in which intraframe correlation is considered (col.5, line 21, "Since

respective frames are independently coded..." shows that each frame is coded with intraframe

correlation, and not interframe correlation.). It would have been obvious to a person of

ordinary skill in the art at the time the invention was made to have combined the teaching of

Normille, Sugiyama and Nguyen, since Normille's apparatus linked the frames to create

forward and backward play (col.8, lines 9-16), and Sugiyama and Nguyen provided the

apparatus for performing the frame edition.

As per dependent claim 6, Normille and Nguyen do not disclose that the intraframe

encoded images after edited is recorded and stored in intraframe coding. However, this would

Serial Number: 08/907,635
Art Unit: 2776

have been an obvious step to one of ordinary skill in the art, since if the frames were not displayed at the time, they should have been stored in the compressed format to reduce storage requirement.

As per dependent claims 7 and 8, Sugiyama discloses that the **animating image data is transmitted from an external apparatus by communication** (Fig.4, item 17 shows that the data come from external apparatus).

As per dependent claims 9 and 10, Nguyen discloses **an edition in a time base direction between frames** (col.7, line 17-20, "a timing diagram showing synchronization ..."). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teaching of Sugiyama and Nguyen, since the image data of Sugiyama also represented animation frames that are organized in time based sequences.

As per dependent claims 11 and 12, Nguyen discloses decoding **from the intraframe just before the frame to be edited** (decoding the intraframe is shown in the rejection of claim 1, which is herein incorporated; and in Nguyen, col.2, line 3, "...generator decompresses and stores ..." shows the decoding before the editing.). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have incorporated Nguyen's feature of decoding just before editing, since decoded data that were not to be used right away would have taken excessive memory storage.

As per dependent claim 13, Sugiyama discloses **displaying the decoded image data** (in Abstract, line 3, "..image editing necessary ...in a processing system for ...displaying ...").

Independent claim 37 is for a method performed by the apparatus of claim 5, and is similarly rejected under the same rationale.

As per dependent claims 41 and 42, which are dependent on claims 9 and 10, respectively, although the prior art does not explicitly teach the means for cutting a frame and inserting a frame. Sugiyama and Nguyen disclose the means for editing by selecting image frames. Therefore, the means for cutting a frame and inserting a frame would have been obvious to a person of ordinary skill in the art at the time the invention was made, since such means were well known elements of editing frames.

As per dependent claim 44, which is dependent on claim 4, Nguyen discloses **animation images displayed in multi-screen displays that are obtained by reducing the frame images** (FIG.9 and col.9, lines 15-30). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teachings of Nguyen and Sugiyama, since Nguyen taught the specific features of editing animation frames, and Sugiyama explicitly suggested performing moving frame editions.

Independent claims 46 and 48 recite substantially similar limitations as claims 5 and 37, respectively, and are similarly rejected under the same rationale. Furthermore, although Sugiyama does not explicitly disclose that the moving image are encoded in MPEG format, such would have been obvious to a person of ordinary skill in the art at the time of the

invention, since Normille explicitly suggests using the MPEG encoding when the standard is finished (col.6, lines 38-45), and Applicant disclosed in the Background of Invention (page 1), that MPEG coding was an international standard for motion video interframe compression at the time of the invention.

Independent claims 50 and 52 recite substantially similar limitations as claims 5 and 37, respectively, and are similarly rejected under the same rationale. Furthermore, Sugiyama teaches that the image data is encoded in H.261 (col.3, line 10).

9.   Claim 40 is rejected under 35 U.S.C. § 103 as being unpatentable over <u>Bonomi</u>.

As per dependent claims 40, which is dependent on claim 3, Bonomi discloses the means for editing by selecting image frames. Therefore, the means for cutting a frame and inserting a frame would have been obvious to a person of ordinary skill in the art at the time the invention was made, since such means were well known elements of editing frames.

10.   Claims 43 remains rejected under 35 U.S.C. § 103 as being unpatentable over <u>Bonomi</u> in view of <u>Nguyen</u>, U.S. Pat. No. 5,404,437, 4/95 (filed 11/92).

As per dependent claim 43, which is dependent on claim 4, Nguyen discloses **animation images displayed in multi-screen displays that are obtained by reducing the frame images** (FIG.9 and col.9, lines 15-30). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teachings of Nguyen and Bonomi, since Nguyen taught the specific features of editing animation frames,

and Bonomi explicitly suggested performing animation frame editions (col.1, line 52, "editing activities include special effects ...").

11.   Claims 49 and 51 are rejected under 35 U.S.C. § 103 as being unpatentable over Bonomi in view of Normille et al., U.S. Pat. No. 5,267,334, 11/93.

Independent claims 49 and 51 recite substantially similar limitations as claims 1 and 36, respectively, and are similarly rejected under the same rationale. Furthermore, Bonomi only teaches that the moving image data are encoded by MPEG, encoding in H.261 would have been obvious to a person of ordinary skill in the art at the time of the invention, since Normille explicitly pointed out that H.261 and MPEG were both extremely well known standards.

Response to Amendment

12.   Applicant's arguments filed 8/18/98 have been fully considered but they are not persuasive.

On page 8 of the amendment Applicant makes the following arguments:

> Applicants submit that their JP '083 priority document was filed in Japan January 31, 1994, prior to Bonomi's U.S. filing date of February 17, 1994. Applicant's respectfully submit that JP '083 provides proper support for the pending claims, and thus antedates the Bonomi reference. Accordingly, it is respectively submitted that the rejection has been overcome and the application is now in condition for allowance.

In response to the above argument, which Applicant has continued to present since the amendment filed 8/18/98 (Paper #22), Examiner would like to make the following statements to clarify the record.

The present application claims the foreign priority under 35 U.S.C. § 119 based on two Japanese patent applications: application <u>6-010083 filed 1/31/94 (hereinafter JP '083)</u> and application <u>7-007389 filed 1/20/95 (hereinafter JP '389)</u>. Both applications teach the techniques of decoding encoded-video frames for user editing. However, there is a MAJOR difference between the two applications. The JP '083 application only teaches detecting and decoding the intraframe-encoded frames (i.e., the frame is compressed with information within its own frame) for editing. The JP '389 application also teaches detecting and decoding the intraframe-encoded frames, <u>but also teaches</u> decoding the interframe-encoded frames (i.e., the frame is compressed with information from other frames) and converting them into intraframe-encoded frames for editing.

Simply put, the earlier filed JP '083 application <u>does not</u> provide the support for "converting means for converting encoded moving image data encoded by an encoding method that includes encoding using interframe correlation to an intraframe encoded moving image" in Claim 1, for example. Nevertheless, Applicant continues to make the blanket statement (such as above) alleging that the JP '083 application provides the support for the claim, and thus the priority date overcomes the Bonomi reference. What Applicant is trying to do, it appears, is claiming the subject matter taught in the later priority document (JP '389), yet claiming the priority date of the earlier priority document (JP '083). This is, at best, improper. In fact,

this appears to be bordering fraudulent practice. It should be noted that Examiner has

previously tried to give the benefit of the doubt by pointing out this matter on two separate

occasions (Papers #26 and #27). Still, applicant only responses by making the general

statement, such as quoted above.

Conclusion

this appears to be bordering a fraudulent practice. It should also be noted that Examiner has

previously tried to give the benefit of the doubt by pointing out this matter on two separate

occasions (Papers #26 and #27).

Conclusion

13.   Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Steve Hong whose telephone number is (703) 308-5465. The
examiner can normally be reached on Monday-Friday from 8:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Heather Herndon, can be reached on (703) 305-9701.

Any inquiry of a general nature or relating to the status of this application should be
directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, D.C. 20231
or faxed to:
(703) 308-9051, (for formal communications; please mark "EXPEDITED
PROCEDURE")
Or:
(703) 305-9724 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA.,
Sixth Floor (Receptionist).

Stephen Hong

Primary Examiner

September 7, 1999